UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _16 January 2008_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _19-37 and 48-84_ is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _19-37 and 48-84_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on _30 April 2004_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _12/5/05, 4/22/05_.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1.   Applicant's election without traverse of claims 19-37, 48-84 in the reply filed on

1/16/2008 is acknowledged.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

> Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.
>
> When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).
>
> In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims 37, 64 is/are rejected under 35 U.S.C. 101 because the claimed invention

is directed to non-statutory subject matter as follows. Claim 37, 64 defines "a

downloadable set of processor-executable instructions" embodying functional

descriptive material. However, the claim does not define a computer-readable medium

or memory and is thus non-statutory for that reason (i.e., "When functional descriptive

material is recorded on some computer-readable medium it becomes structurally and

functionally interrelated to the medium and will be statutory in most cases since use of

technology permits the function of the descriptive material to be realized" – Guidelines

Annex IV). That is, the scope of the presently claimed "a downloadable set of

processor-executable instructions" can range from paper on which the program is

written, to a program simply contemplated and memorized by a person. The examiner

suggests canceling the claims (i.e. as they appear to embody the same processor

executable instructions as claims 36 and 63) or amending the claims similarly to claims

36 and 63 respectively. Any amendment to the claim should be commensurate with its

corresponding disclosure.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 19, 22-31, 34-37, 48-51, 54-55, 57-60, 62-69, 71, 73-74, 77, 80 are

rejected under 35 U.S.C. 102(e) as being anticipated by Outten et al. (US 7024466).

Claims 19 and 48, Outten discloses an improved method for purchasing movies

for playback, the method comprising:

- displaying an online catalog (website) for a user to select movies for playback (col. 6, lines 5-12, lines
  28-37);

- receiving encrypted copies of selected movies at a set-top box (e.g. UND) with Internet connectivity,
  at least some of the encrypted copies being received from other set-top boxes (peer-to-peer
  connectivity in context of invention) (col. 5, lines 48-49, col. 6, lines 13-14);

- receiving purchase information (license) from the user for a particular one of the selected movies that
  have been received at the set-top box (col. 6, lines 38-54); and

- in response to the purchase information, authorizing playback of the particular one of the selected
  movies (col. 6, lines 63-67).

Claims 20 and 60, Outten teaches the method of claim 19, wherein encrypted

copies received at the set-top box are stored on a hard disk (movies are downloaded to

UND) (col. 4, lines 63-65, col. 18, lines 58-61).

Claim 22, Outten teaches the method of claim 19, further comprising: transferring

movies received at the set-top box to other set-top boxes (using peer-to-peer

connectivity) (col. 5, lines 5-27).

Claim 23, Outten teaches the method of claim 22, wherein the transferred movies are transferred from the set-top box to other set-top boxes using peer-to-peer connectivity (col. 5, lines 5-27).

Claim 24, The method of claim 23, wherein the peer-to-peer connectivity is controlled by a server (col. 5, lines 10-27). *The disclosed invention, specifically relating to the distribution of content through the different servers, may be operated through peer-to-peer connectivity. Thus, it meets the limitations as required by this claim.*

Claim 25, Outten teaches the method of claim 19, wherein the user selects movies from the online catalog using a browser (web interface) (col. 6, lines 28-37).

Claims 26 and 49, Outten teaches the method of claim 19, wherein the user selects movies from the online catalog using the set-top box connected to a television (col. 5, line 55).

Claim 27, Outten teaches the method of claim 19, wherein at least some of the selected movies are received from a central repository (storage facility 36) (col. 11, lines 3-6).

Claim 28, Outten teaches the method of claim 27, wherein the central repository includes multiple media servers (parent servers, edge servers, main server) storing encrypted copies of movies (col. 13, lines 24-48).

Claims 29 and 51, Outten teaches the method of claim 19, further comprising: in response to the authorizing step (purchasing a license), decrypting the particular movie purchased and playing it back on a television (col. 8, line 64-col. 9, line 8, col. 15, lines 52-55).

Claim 30, Outten teaches the method of claim 29, further comprising: checking account status (enabling license) of the user before decrypting the particular movie (col. 18, lines 6-12).

Claim 31, Outten teaches the method of claim 29, further comprising: checking (verifying) geographic location of the set-top box before decrypting the particular movie (col. 16, lines 57-60).

Claim 34, Outten teaches the method of claim 19, wherein said step of receiving (at the edge servers) encrypted copies of selected movies includes receiving encrypted copies of movies selected based, at least in part, on predicted demand (e.g. "hot" items) for movies (col. 14, lines 35-38).

Claim 35, Outten teaches the method of claim 19, wherein said step of receiving encrypted copies of selected movies includes receiving encrypted copies selected based, at least in part, on optimizing distribution (using multiple layer network architecture) of movies to a plurality of set-top boxes (col. 3, lines 51-67).

Claim 36, it is inherent that Outten contain "a computer readable medium" for performing the steps of claim 19.

Claim 37, Outten teaches downloaded able processor instructions (col. 11, lines 20-26). *Main server transmits instructions to the parent and edge servers, hence they are downloaded.*

Claim 50, Outten teaches the method of claim 49, wherein said display device comprises a television and the client device comprises a set-top box capable of rendering videos on the television (col. 5, lines 48-64).

Claim 54, Outten teaches the method of claim 48, wherein said connecting step includes connecting the client device to the broadband connection using a selected one of wireless networking, wireline networking, powerline networking, and phone line networking (col. 5, lines 10-27).

Claim 55, Outten teaches the method of claim 48, wherein the client device

includes powerline networking (directly wired set of stations) capability for connecting to

the broadband connection (col. 5, lines 10-27).

Claim 58, Outten teaches the method of claim 48, wherein said step of providing

a decryption key includes issuing a request for the decryption key to the Web server in

response to a user requesting playback at the client device (col. 15, lines 41-55).

Claim 59, Outten teaches the method of claim 58, wherein said Web server

obtains payment authorization (purchasing a license) for the video before providing the

decryption key (access to decrypt the encrypted program) (col. 8, lines 36-52, col. 9,

lines 4-8).

Claim 62, Outten teaches the method of claim 60, further comprising: in response

to an instruction from the Web server (purchased license), transmitting a copy of a given

video stored in encrypted format at the client device to another client having peer-to-

peer connectivity with the client device (col. 5, lines 10-20). *The disclosed invention,*

specifically relating to the distribution of content through the different servers, may be

operated through peer-to-peer connectivity Outten teaches the embodiments of the

present invention with use of a peer-to-peer connectivity.

Claim 63, it is inherent that Outten contain "a computer readable medium" for performing the steps of claim 48.

Claim 64, Outten teaches downloaded able processor instructions (col. 11, lines 20-26). *Main server transmits instructions to the parent and edge servers, hence they are downloaded.*

Claim 66, Outten teaches the system of claim 65, wherein said media files comprise various file types (col. 4, lines 29-36).

Claim 67, Outten teaches the system of claim 65, wherein said media files comprise selected ones of audio files and video files (col. 4, lines 29-36).

Claim 65 is analyzed as an apparatus of claims 29, 48, 50, 60.

Claim 68 is analyzed as an apparatus of claim 19.

Claim 69 is analyzed as an apparatus of claim 29.

Claim 71 is analyzed as an apparatus of claim 55.

Claim 73 is analyzed as an apparatus of claim 54.

Claim 74 is analyzed as an apparatus of claim 55.

Claim 77 is analyzed as an apparatus of claim 62.

Claim 80 is analyzed as an apparatus of claims 19, 29.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Outten

et al. (US 7024466) in view of Wagner et al. (US 6871323).

        Claim 21, Outten is silent regarding the method of claim 19, further comprising:

providing feedback to the user indicating transfer status of each movie being received.

        Wagner teaches the method further comprising: providing feedback (progress

indicator) to the user indicating transfer status of each movie being received (figs. 8a-

8d; col. 7, lines 9-62).

        Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have provided a progress indicator for downloads as

taught by Wagner to the system of Outten to display to the user the various stages of a

download (col. 7, lines 9-28).

6.   Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Outten

et al. (US 7024466) in view of Hendricks (US 6557173).

Claim 32, Outten is silent regarding the method of claim 19, wherein playback is

authorized for a limited period of time.

Hendricks teaches regarding the method wherein playback is authorized for a

limited period of time (col. 11, lines 60-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have provided a time limit to programs as taught by

Hendricks to the system of Outten to provided limited access for providers (col. 11, lines

60-65).

7.   Claims 33, 75-76, 78-79 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Outten et al. (US 7024466) in view of Asamoto et al. (US 7017179).

Claim 33, Outten is silent regarding the method of claim 19, further comprising:

creating a priority list for each user, based on user selections from the online catalog,

said priority list controlling at least in part which movies are received at a given set-top

box.

Asamoto teaches the method further comprising: creating a priority list for each

user, based on user selections from the online catalog, said priority list controlling at

least in part which movies are received at a given set-top box (col. 8, lines 45-56).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have provided a download priority scheme as taught by

Asamoto to the system of Outten to receive programs of overlapping broadcasts (col. 2,

lines 38-42).

Claim 75 is analyzed as an apparatus of claim 33.

Claim 76 is analyzed as an apparatus of claims 23, 33.

Claim 78 is analyzed as an apparatus of claim 33.

Claim 79 is analyzed as an apparatus of claim 33.

8.   Claims 52, 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Outten et al. (US 7024466) in view of Bogot (US 7337464).

Claim 52, Outten is silent regarding the method of claim 51, wherein said set-top

box includes capability for one-chip decryption and rendering of videos in encrypted

format, thereby serving to secure said encrypted videos against unauthorized use.

Bogot teaches regarding the method wherein said set-top box includes capability

for one-chip decryption (DES decryption) and rendering of videos in encrypted format,

thereby serving to secure said encrypted videos against unauthorized use (col. 5, lines

38-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have provided DES decryption as taught by Bogot to the

system of Outten to provide conditional access (col. 5, lines 38-53).

Claim 70 is analyzed as an apparatus of claim 52.

9.   Claims 53, 72, 82-84 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Outten et al. (US 7024466).

Claim 53 further comprises the method wherein said connecting step includes

connecting using a selected one of a cable modem and a DSL modem (Outten teaches

a system connectable to the Internet through wide area networks (col. 5, lines 10-27).

OFFICIAL NOTICE is taken that it is common practice to use a cable modem or a DSL

modem for connectivity to wide area networks.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have provided a cable modem to the system of Outten

to provide connectivity to a wide area network.

Claim 72 is analyzed as an apparatus of claim 53.

Claims 82-84 further comprise a remote control device for a user to issue

instructions to the set-top box, select media files for playback, and request media files

from the catalog (Outten teaches a user issuing instructions to the UNDs, requesting

and playing media files from an online catalog as noted in claims 19 and 48, see col. 6,

line 4-col. 7, line 22). OFFICIAL NOTICE is taken that it is common practice to use a

remote control device with a set top box (e.g. UND).

10.   Claims 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Outten et al. (US 7024466) in view of Karaoguz et al. (US 7257549).

        Claim 56, Outten is silent regarding the method of claim 48, wherein said step of

transferring an encrypted copy includes substeps of:

- locating a peer client device on the Internet having an encrypted copy of the selected video; and

- transferring the encrypted copy of the selected video from the peer client device to the client device.

        Karaoguz teaches the method wherein said step of transferring an encrypted

copy includes substeps of:

- locating a peer client device (pre-defined users) on the Internet having an encrypted copy of the selected video (col. 9, lines 9-14); and

- transferring the encrypted copy of the selected video from the peer client device to the client device (col. 9, line 61-col. 10, line 17).

        Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have provided the peer-to-peer connectivity as taught

by Karaoguz to the system of Outten to allow users to effectively become their own

broadcasters from their own homes (col. 9, lines 4-8).

        Claim 57, Outten teaches the method wherein the peer client device comprises a

set-top box (UND) client having peer-to-peer connectivity with the client device (col. 5,

lines 5-27).

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11.   Claims 61, 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Outten et al. (US 7024466) in view of Watson et al. (US 2004/0133923).

Claim 61, Outten is silent regarding the method further comprising initializing the

client device using a secure client device boot process, thereby serving to secure said

videos stored on the client device.

Watson teaches the method further comprising initializing the client device using

a secure client device boot process, thereby serving to secure said videos stored on the

client device (paragraph [0124]).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have provided a secure boot process as taught by

Watson to the UND's of Outten to preserve copyrights (paragraph [0122]).

Claim 81 is analyzed as an apparatus of claim 61.

Inquiries

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MUSHFIKH ALAM whose telephone number is

(571)270-1710. The examiner can normally be reached on Mon-Fri: 8:30-18:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MA
4/7/2008

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Primary Examiner, Art Unit 2623